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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,445	01/06/2005	Takuji Himeno	450100-04677	2788

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EXAMINER

HARVEY, DAVID E

ART UNIT	PAPER NUMBER
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2621

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01/06/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,445	Applicant(s) HIMENO ET AL.	
	Examiner DAVID E. HARVEY	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 13-15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 4, 9-12, 16 and 21-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/31/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2621

1. In the response filed 9/21/2009, applicant contends that the double patenting rejection no longer applies because the copending case has been abandoned. However, to date, the copending case has not been abandoned.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9/1 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 1 is broader and is anticipated by said claim 9/1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 2621

4. Claim 2/1 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10/9/1 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 2/1 is broader and is anticipated by said claim 10/9/1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 3/1 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11/9/1 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 3/1 is broader and is anticipated by said claim 11/9/1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 5/1 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12/9/1 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 5/1 is broader and is anticipated by said claim 12/9/1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claim 6/5/1 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13/12/9/1 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 6/5/1 is broader and is anticipated by said claim 13/12/9/1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 2621

8. Claim 7/6/5/1 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14/13/12/9/1 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 7/6/5/1 is broader and is anticipated by said claim 14/13/12/9/1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claim 8/5/1 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15/12/9/1 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 8/5/1 is broader and is anticipated by said claim 15/12/9/1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claim 13 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 36/28 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 13 is broader and is anticipated by said claim 36/28.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claim 14/13 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37/36/28 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 14/13 is broader and is anticipated by said claim 37/36/28.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claim 15/13 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 38/36/28 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 15/13 is broader and is anticipated by said claim 38/36/28.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 2621

13. Claim 17/13 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 39/36/28 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 17/13 is broader and is anticipated by said claim 39/36/28.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claim 18/17/13 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 40/39/36/28 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 18/17/13 is broader and is anticipated by said claim 40/39/36/28.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claim 19/18/17/13 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 41/40/39/36/28 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 19/18/17/13 is broader and is anticipated by said claim 41/40/39/36/28.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claim 20/17/13 of instant application 10/520,445 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 42/40/39/36/28 of copending Application No. 10/520,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 20/17/13 is broader and is anticipated by said claim 42/40/39/36/28.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 2621

17. Claims 4, 9-12, 16, 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DAVID E. HARVEY** whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

**DAVID E HARVEY
Primary Examiner
Art Unit 2621**